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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,391	06/25/2001	Jacoba Adriana De Ronde	1930-A-PCT	9219

7590

04/09/2003

Joseph A Sebolt  
Sand & Sebolt  
Aston Park Professional Centre  
4801 Dressler Road NW Suite 194  
Canton, OH 44718

EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

10

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,391

Applicant(s)

DE RONDE ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of the Claims***

1. The Office acknowledges receipt of Applicants Response; dated 21 January 2003, paper number 9. Applicant has cancelled claims 21 and 22, and amended claims 1-20. Claims 1-20 are pending, and are examined in the instant action.
2. The effective filing date for this case is the PCT filing date, 14 October 1999. Benefit of foreign priority requires that the priority document or a certified English translation be submitted. Applicant has traversed this stating that the priority document, ZA 98/9427 (filing date 15 October 1998) was filed under Rule 17.2 PCT, with the International Bureau. The Office maintains that the effective filing date for this case is the PCT filing date, 14 October 1999, and that until such time as the priority document, a certified English translation of the document, or a copy of the document, is received, Applicant shall have the benefit of the PCT filing date. See 35 USC 365 (a), (b), and 35 USC 119 (b)(1) and (3).
3. This action is made FINAL necessitated by Applicant's amendment.
4. All rejections not addressed below have been withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112, second paragraph***

6. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, recites "gene". Claims which recite "gene" are unclear because a "gene" implies a DNA sequence that exists in nature and includes coding and noncoding regions, as well as all regulatory sequences associated with expression. All recitations of this language are also rejected. In claim 1, suggested language is "an Agrobacterium stain comprising a DNA of interest, thereby genetically modifying the plant seed".

In claim 5, "it" lacks antecedent basis; is "it" vacuum infiltration" or "seed" or something else?

Claim 12 recites "gene". Claims which recite "gene" are unclear because a "gene" implies a DNA sequence that exists in nature and includes coding and noncoding regions, as well as all regulatory sequences associated with expression. All recitations of this language are also rejected. Also, "a selection agent resistance DNA" is not clear; does this mean that the DNA is resistant? Suggested language is "DNA of interest and DNA comprising a selectable marker, the DNA comprising a selectable marker also". It is also suggested that all recitations of "a selection agent resistance DNA" be similarly clarified.

In claim 14, "GUS-intron" is unclear because this implies that the intron is part of GUS, which it not the case, as GUS is a bacterial coding sequence, and bacterial

coding sequences do not naturally contain introns. Suggested language is "GUS coding sequence comprising an intron".

***Claim Rejections - 35 USC § 102***

7. Claims 1-9, 12, 13, 14, and 19-20 remain rejected under 35 U.S.C. 102(b) as being anticipated by Clough et al, 1998, Plant Journal, Vol 16, No. 6, pages 735-743. (Applicant's IDS)

Clough teaches a method of obtaining transformed seed by contacting germinating plant seed with a wetting agent and Agrobacterium (Summary, p 735), an Agrobacterium and wetting agent admixture (Figure 2, p 738, and Table 3, p 739), vacuum infiltration (Table 1, p737), a contact period of 24 hours, and a temperature of 24 degrees C, Agrobacterium tumefaciens (Abstract), a foreign gene comprising a resistance gene (p 741, 1<sup>st</sup> column, last sentence), plant seed, plants, and progeny (Table 3, p 739).

Accordingly Clough anticipates the claimed invention.

8. Applicant traverses, stating primarily that the priority document, ZA 98/9427 (filing date 15 October 1998) was filed under Rule 17.2 PCT, with the International Bureau. And that thus the Clough reference is obviated as a reference. The Office maintains that the effective filing date for this case is the PCT filing date, 14 October

1999, and that until such time as the priority document or a certified English translation is received, Applicant shall have the benefit of the PCT filing date. See (2) supra.

**Remarks**

9. No claim is allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

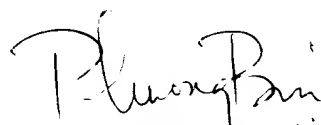
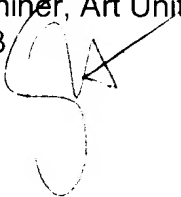
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia Helmer PhD  
Patent Examiner, Art Unit 1638  
April 4, 2003

  
PHUONG T BUI 4/4/03  
PRIMARY EXAMINER